Status of the Claims

Claims 1–27 remain pending in the application, Claims 14 and 27 having been amended to more clearly define the claim limitations.

Claims Rejected under 35 U.S.C. § 103(a)

In the Office Action, the Examiner has rejected Claims 1-27 as being unpatentable over Buxton et al. (U.S. Patent No. 6,469,714, hereinafter "Buxton") in view of Berry et al. (U.S. Patent No. 4,789,962, hereinafter "Berry") in view of Grossman et al. (U.S. Patent No. 5,852,440), hereinafter "Grossman"). Applicants respectfully disagree with the rejection for the reasons discussed below.

In the interest of reducing the complexity of the issues for the Examiner to consider in this response, the following discussion focuses on independent Claim 1, and amended independent Claims 14 and 27. The patentability of each remaining dependent claim is not necessarily separately addressed in detail. However, applicants' decision not to discuss the differences between the cited art and each dependent claim should not be considered as an admission that applicants concur with the Examiner's conclusion that these dependent claims are not patentable over the disclosure in the cited references. Similarly, applicants' decision not to discuss differences between the prior art and every claim element, or every comment made by the Examiner, should not be considered as an admission that applicants concur with the Examiner's interpretation and assertions regarding those claims. Indeed, applicants believe that all of the dependent claims patentably distinguish over the references cited. However, a specific traverse of the rejection of each dependent claim is not required, since dependent claims are patentable for at least the same reasons as the independent claims from which the dependent claims ultimately depend.

Rejection of Independent Claim 1

Significant differences exist between the cited art and independent Claim 1 because the cited art does not teach or suggest that a palette comprises a control only for an available property. Notice that applicants' first function of their third step recites (with emphasis added) "creating a customized palette for the user interface **so that the palette comprises a control only for an available property.**" The Examiner asserts that Buxton teaches differentiating and determining available icons from unavailable icons and cites column 7, lines 58-69 of Buxton, but acknowledges that Buxton does not completely eliminate the unavailable icons from the display screen. The Examiner also asserts that Grossman teaches eliminating unwanted icons from the display screen and cites column 9, lines 60-66 of Grossman, while

-7-

MS # 150899.01
MICR0247-1-1\0247AM 01-23-2006.doc

LAW OFFICES OF RONALD M. ANDERSON
600 - 108th Avenue N.E., Suite 507
Bellevue, Washington 98004
Telephone: (425) 688-8816   Fax: (425) 646-6314

acknowledging that Grossman's method of determining unwanted icons is different from Buxton's method of determining unavailable icons. The Examiner concludes that if one combines Grossman's teaching with Buxton's method, the combined cited art would teach eliminating unavailable icons from the display screen and thus only display icons that are available. The Examiner's citation to Buxton and Grossman are reproduced below and the portions cited by the Examiner are underlined:

<u>Action Bar Items Showing State and Availability</u> (Buxton, column 7, line 57.)

<u>Action Items 324 that toggle on or off may show the current status of the selected object, examples include Bold and Italic, as illustrated in FIG. 3D. Action items 324 that are not available in the current context are dimmed. For example, Paste should be dimmed when nothing is on the clipboard. Menu commands that are identical to action items may mirror the behavior of the corresponding action item. If the Paste Action Item is dimmed because nothing is on the clipboard, the Paste menu item may also be dimmed.</u> (Buxton, column 7, lines 59-67.)

In a further effort to clean up a computer display or a messy desk top, a technique is provided wherein the visual clutter is reduced by gradually removing those elements from the display which have not been recently used, and optionally, closing the associated computer sessions in order to reduce the processor load. As described below, in accordance with the principles of the present invention, desk top elements, such as icons, which have not been used for some time or with a low expected probability of use have a gradual change in their appearance. As examples, they may grow hazy or fade into the background, their actual dimensions may be changed so that they shrink until they disappear or they shrink along one dimension appearing to be squashed, they move or drift to the edge of the display or they have an intensity border which grows along the perimeters of the icons the longer the icons have been inactive. <u>With the intensity border, in a further example, once the border is complete, the icon is considered unused beyond a predefined time-out limit and it is removed from the screen. Selecting the icon would reset the intensity border. For instance, a 3600 pixel border could have one pixel illuminated every one second. At the end of one hour, for this example,</u> the icon's intensity border would be complete and the inactive icon would be removed to free system resources, such as, for example, an OS/2 thread. (Grossman, column 9, lines 45-column 10, line 2.)

Applicants' respectfully disagree with the Examiner's assertion. For example, if one of ordinary skill in the art were to combine Buxton's (1) dimmed (i.e., unavailable) action items 324 (column 7, line 62) with Buxton's (2) undimmed (i.e., available) action items 324 (column 7, lines 60-61) with Grossman's (3) unused icon (column 9, lines 46-48), the combination would not yield just item (2) undimmed properties (i.e., only display icons that are available), as the Examiner asserts. Contrary to the

-8-

Examiner's assertion, the result is NOT the equivalent of applicants' claim recitation of a palette comprising a control only for an available property.

Since Grossman teaches fading and subsequently eliminating icons that have not been used for a predefined time, it is apparent that Grossman's fading effect can only be applied to icons that a user has actually used previously, and these icons clearly must be icons that are available in a palette. Thus, this combination of Buxton and Grossman would affect (2) undimmed properties (i.e. only the display of icons related to properties that are available as taught by Buxton), and if (2) an undimmed property had not been used for awhile (i.e., currently the icon is unused), the related icon would fade or disappear (Grossman, column 9, lines 54-56). Thus, if two properties (icons) were undimmed and available to use, but one property or icon had not been used for awhile and the other property or icon had been used very recently, the application of Grossman's teaching would affect the (2) undimmed properties of these two icons and yield (a) one dimmed and fading icon (on its way to being eliminated and (b) one undimmed property or icon that is currently being used. However, notice this combination of cited art results in a display that still retains Buxton's unavailable action items 324 since Grossman teaches only eliminating currently unused properties and therefore Grossman's teaching does not apply to an *unavailable* property because it is not possible to fade and eliminate a property or related icon that unless that property or icon was available to be used previously. Thus, any applicable teaching of Grossman can only affect *available* properties – even if those properties have not been selected by a user for awhile, so as to cause the properties (icons) to fade and eventually disappear. Thus, Grossman cannot be combined with Buxton to achieve what applicants' Claim 1 recites. Clearly, there is a difference between a property that is available but has not been used for awhile, and a property that is completely unavailable.

Accordingly, the rejection of independent Claim 1 under 35 U.S.C. § 103(a) over Buxton in view of Berry and further in view of Grossman should be withdrawn. Because dependent claims include all of the elements of the independent claims from which the dependent claims ultimately depend, and because Buxton in view of Berry and further in view of Grossman does not disclose or suggest all of the elements of independent Claim 1, the rejection of dependent Claims 2-13 under 35 U.S.C. § 103(a) over Buxton in view of Berry and further in view of Grossman should be withdrawn for at least the same reasons as the rejection of Claim 1.

Rejection of Independent Claim 14

Significant differences exist between the cited art and independent Claim 14 because the cited art does not teach or suggest that the palette and an activated associated content of the palette do not obscure the electronic document. Claim 14 is directed to a computer system for providing a selection of formatting properties for an electronic document associated with an application program having a user interface. With regard to independent Claim 14, the Examiner asserts that it is of similar scope to Claim 1, and thus, is rejected under the same rationale. Specifically, the Examiner asserts that Berry teaches that an activated associated content of the palette does not obscure viewing of said electronic document and cites column 4, lines 1-35 and lines 58-67, which are reproduced below:

> Refer next to FIG. 2. In this figure is shown a full screen display of a selection menu screen 11. On the menu are a number of options such as MARGINS, SCALE LINE, etc. Selection of one of these options is by cursoring a choice and then depressing an ENTER key on the keyboard (not shown) included in the system. For purposes of this application, the cursor is an underline such as line 20 shown below MARGINS. Cursoring down one line will cause the underline to be displayed under SCALE LINE. (Berry, column 4, lines 1-10.)

> Selection of MARGINS upon depressing the ENTER key will cause another screen to be displayed. On this other screen will be the left and right margins for the job to be, or being, performed. These margins may be presented as marks on a scale line, vertical lines extending down the screen, etc. (Berry, column 4, lines 11-16.)

> With the underline under MARGINS, depression of a HELP, or equivalent function key on the keyboard will result in help being displayed. (Berry, column 4, lines 17-19.)

> **For help to be displayed, a quadrant from FIG. 1 is sought having sufficient blank space to position a minimum amount of meaningful help**. Since no such quadrant exists, a minimum amount of meaningful help is written into and over a portion of the information in the 4th quadrant. The reason this quadrant is selected rather than the 3rd quadrant is that help was called while MARGINS was cursored. MARGINS forms part of an option field with related information. SCALE LINE, PAGE SIZE and TYPESTYLE are the other parts of the option field. It is desirable not to have related information overlayed or covered up with help. The reason help is not written into the second quadrant is that this quadrant also contains information related to MARGINS. This information is the wording "view or change left/right margins." (Emphasis added, Berry, column 4, lines 20-35.)

> Referring next to FIG. 3, there is shown a screen 15. On screen 15 are windowed options of selection menu 16, and windowed help 17 occasioned by the calling of help while cursoring MARGINS. One result of windowing menu 16 as shown is that the screen

is vertically divided leaving the right half available for help 17. This is a particularly attractive embodiment in that much more room is available for help information. Also, as windowed, the option field is left intact. (Berry, column 4, lines 57-66.)

However, the cited art does not teach or suggest the recitation of applicants' amended claim regarding "sending the palette to a user interface associated with the application program for display adjacent to a viewing content area occupied by the electronic document, such that the palette and an activated associated content of the palette do not obscure the viewing content area occupied by the electronic document." As shown in applicants' Figure 5 and as applicants' recite in the specification, "When a user desires to access one or more properties of the electronic document 504, the user can view the formatting palette 502 while viewing content 506 of the electronic document 504 without the formatting palette 502 overlapping the viewable content 506 of the electronic document 504," (page 17, lines 7-11). Notice that a palette and its activated associated content are displayed proximate the viewing area of the electronic document, so as not to overlay or obscure any portion of the viewing content area of the electronic document. In contrast, as noted in the bold font portion of Berry reproduced above, although a blank portion of the quadrant is sought to display the help menu, nevertheless Berry will still obscure and overlay a portion of the viewable content area (even if the portion being overlaid is blank) and further, does not display the help menu *adjacent* to a quadrant wherein viewable content is displayed. In addition, notice that Figure 3 of Berry displays selection menu 15 and windowed help 17 disposed adjacent to one another. In contrast to applicants' claim recitation, selection menu 15 and windowed help 17 still *obscure* the viewable content area of screen 15 in Berry's Figure 3.
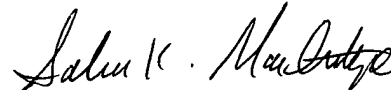
Thus, Claim 14 also distinguishes over Buxton in view of Grossman and further in view of Berry. Accordingly, the rejection of independent Claim 14 under 35 U.S.C. § 103(a) over Buxton in view of Berry and further in view of Grossman should be withdrawn. Because dependent claims inherently include all of the elements of the independent claims from which the dependent claims ultimately depend, and because Buxton in view of Berry and further in view of Grossman does not disclose or suggest all of the elements of independent Claim 14, the rejection of dependent Claims 15-26 under 35 U.S.C. § 103(a) over Buxton in view of Berry and further in view of Grossman should be withdrawn for at least the same reasons as the rejection of Claim 14.

MS # 150899.01
MICR0247-1-1\0247AM 01-23-2006.doc

Rejection of Independent Claim 27

With regard to amended independent Claim 27, the Examiner asserts that it is rejected under the same rationale as Claims 1, 2, 3, 4, and 9. Claim 27 is directed to a computer system for providing a selection of formatting properties for an electronic document associated with an application program having a user interface. Applicants' specification states that "the modified palette can be resized so that the electronic document is simultaneously viewable with the modified palette when the modified palette is displayed on an associated display 47" (page 22, lines 21-24.) Thus, for the same reasons already noted above in traversing the rejection of Claim 14, Claim 27 also distinguishes over Buxton in view of Grossman and further in view of Hamilton, because unlike the teaching of the combined cited references, the claim provides that the modified palette and its associated content are displayed *adjacent* to the viewing area of the electronic document so as *not to obscure* the viewing area of the electronic document. Accordingly, the rejection of independent Claim 27 under 35 U.S.C. § 103(a) over Buxton and further in view of Hamilton and Grossman should be withdrawn.

In view of the amendments and Remarks set forth above, it will be apparent that the claims in this application define a novel and non-obvious invention, and that the application is in condition for allowance and should be passed to issue without further delay. Should any further questions remain, the Examiner is invited to telephone applicants' attorney at the number listed below.

Respectfully submitted,

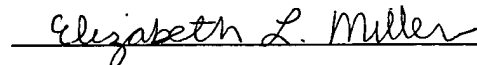*Sabrina K. MacIntyre*

Sabrina K. MacIntyre
Registration No. 56,912

SKM/RMA:elm

MAILING CERTIFICATE

I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid addressed to: Commissioner for Patents, Alexandria, VA 22313-1450, on January 23, 2006.

Date: January 23, 2006

Elizabeth L. Miller

MS # 150899.01
MICR0247-1-1\0247AM 01-23-2006.doc